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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,692	09/26/2003	Satoshi Hiratsuka	YAMA:059	9284
37013 7590 04/01/2009 ROSSI, KIMMS & McDOWELL, LLP. 20609 Gordon Park Square, Suite 150 Ashburn, VA 20147			EXAMINER WILLIAMS, JEFFERY L.	
			ART UNIT 2437	PAPER NUMBER
			MAIL DATE 04/01/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,692

Applicant(s)

HIRATSUKA, SATOSHI

Examiner

JEFFERY WILLIAMS

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1 – 14 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/16/09 has been entered.

Claim Objections

Claim 1 is objected to because of the following informalities:

Regarding claim 1, the recitation [lines 19-22] “...for sending ... the copy permission request ... each time before the downloaded contents are to be copied...” is ambiguous. The examiner notes, in harmony with the applicant's specification, that it appears that the applicant intends for an apparatus capable of sending a new “copy permission request” each time a copy is desired to be made. Thus, the examiner presumes the applicant to recite “...for sending ... a copy permission request ... each

1 *time before the downloaded contents are to be copied...*. Appropriate correction is
2 required.

3
4 ***Claim Rejections - 35 USC § 112***

5
6 The following is a quotation of the second paragraph of 35 U.S.C. 112:

7 The specification shall conclude with one or more claims particularly pointing out and distinctly
8 claiming the subject matter which the applicant regards as his invention.

9
10 Claims 1 – 5 and 12 are rejected under 35 U.S.C. 112, second paragraph, as
11 being indefinite for failing to particularly point out and distinctly claim the subject matter
12 which applicant regards as the invention.

13
14 Regarding claim 1, the recitation [line 15] *"the request stored* in the server storing
15 device" lacks antecedent basis with the claim. For the purpose of examination, the
16 examiner presumes the applicant to recite "a request stored in the server storing
17 device".

18 Claims 2 – 5 and 12 are rejected by virtue of dependency.

19
20 ***Claim Rejections - 35 USC § 102***

21
22 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
23 form the basis for the rejections under this section made in this Office action:

24 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 14 are rejected under 35 U.S.C. 102(b) as being anticipated by

Nozaki et al., (Nozaki), US Patent Publication 2002/0036800 A1.

Regarding claim 1, Nozaki discloses:

A contents supplying server apparatus that supplies contents for downloading via a communication network; and an information processing terminal that receives the contents from the server apparatus for at least one user (fig. 2:1, 2a)

Wherein the server apparatus comprises: a server storing device for storing, together with numerous contents, user information for each user, including user ID information and contents purchase information comprising contents ID information and copy control data (fig. 3:8 - herein Nozaki discloses a server storing device); and a server controlling section that, in response to a copy permission request from a user for copying the downloaded contents from said information processing terminal to an external apparatus or recording medium (par. 14, 21, 103), reads out the copy control data of the requested downloaded contents to be copied to the external apparatus or recording medium from the server storing device, supplies the copy control data of the user to said information processing terminal, and amends the copy control data of the user corresponding to the request stored in the server storing device (par. 62, 63, 105-107, 113), and wherein the information processing terminal comprises: a terminal storing device for storing the downloaded contents from the server apparatus (fig. 4:21);

1 *a sending section for sending to the server apparatus the copy permission*
2 *request (par. 77; fig. 4:36, 28) for copying the downloaded contents to the external*
3 *apparatus or recording medium each time before the downloaded contents are to be*
4 *copied to any external apparatus or recording medium (par. 100, 113, 141; fig. 1).*
5 Herein, the examiner notes that the prior art anticipates the recited structure of a
6 "sending section" of the claimed apparatus. However, for the applicant's benefit, the
7 examiner notes that Nozaki anticipates such intended use recitation. Regarding the
8 applicant's description of an intended use for the "sending section", the examiner notes
9 that Nozaki discloses a "sending section" that can be used to make a "copy permission"
10 request each time a copy is to be made. Note, that Nozaki allows copyright holders or
11 distribution servers to limit the copy count at their discretion, such that a user would be
12 required to request a reuse information key before making a copy (par. 100, 113, 141;
13 fig. 1; see also par. 146).

14 *a receiving section for receiving the copy control data of the downloaded*
15 *contents to be copied to the external apparatus or recording medium from the server*
16 *apparatus (par. 78; fig. 4:30, 28);*

17 *and a terminal controlling section for determining whether or not to copy said*
18 *downloaded contents to the external apparatus or recording medium based on the*
19 *received copy control data (fig. 4:35; par. 76).*

20
21 Regarding claim 2, Nozaki discloses:

1 *wherein the copy control data stored in said server storing device represents the*
2 *number of times the downloaded contents are allowed to be copied to the external*
3 *apparatus or recording medium, and is decremented every time the downloaded*
4 *contents are copied from the information processing terminal into the external apparatus*
5 *or recording medium (par. 63, 73, 80).*

6
7 Regarding claim 3, Nozaki discloses:
8 *wherein the user information of said server storing device further includes*
9 *terminal ID information representing one or more information processing terminals*
10 *belonging to one user (par. 89, 101; fig. 2: 2a, 2b, 3, 5, 6),*

11 *and said server controlling section supplies the already downloaded contents by*
12 *the one user without executing a fee-charging process to the information processing*
13 *terminal that has already downloaded the downloaded contents or to another*
14 *information processing terminal belonging to the one user (par. 12-17 – Nozaki does not*
15 *disclose executing a fee charging process for an owner's previously owned contents).*

16
17 Regarding claim 4, Nozaki discloses:
18 *wherein said server storing device stores an initial value of the copy control data,*
19 *contents by contents (par. 63).*

20
21 Regarding claim 5, Nozaki discloses:
22 *wherein said contents are music data (par. 28).*

Regarding claims 6 – 11, they are program and apparatus claims corresponding to claims 1 – 5, and they are rejected, at least, for the same reasons.

Regarding claims 12 – 14, they recite wherein the external apparatus is an electronic musical instrument, however, the examiner notes that "the external apparatus" is not a required limitation of the claims. Therefore, though Nozaki discloses an apparatus capable of reproducing musical notes or sounds (par. 44), it is not necessary to address this recitation.

Response to Arguments

Applicant's arguments filed 2/16/09 have been fully considered but they are not persuasive.

Applicant argues essentially that:

(i) *In maintaining the rejection, the examiner asserts that Nozaki's paragraphs 62, 63, and 105-107 disclose the claimed copy permission controlling aspects. Applicant disagrees because these paragraphs merely refer to how the PC obtains a reproduction-use information key that provides the copy limitation data.* (Remarks, pg. 6)

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

However, in response to applicant's allegation that the prior art merely shows *how the PC obtains a reproduction-use information key*, it is respectfully noted that the prior art clearly shows that a server obtains (i.e. "reads out") copy permission data (i.e. "copy control data") [par. 62, 105, 113], supplies the copy permission data to a user [par. 63, 106, 107], and appropriately modifies it's own version of the copy permission data [par. a terminal features upon which applicant relies [par. 63, 107].

(ii) *Nozaki simply does not seek any permission from the server before each time a copy is to be made to any external apparatus or recording medium. At least in this respect, the pending claims clearly distinguish over Nozaki.* (Remarks, pg. 6)

In response, the examiner respectfully notes that the applicant's arguments are derived from descriptive recitations of intended use. In response to applicant's argument that the prior art fails to disclose *"for sending to the server apparatus the copy permission request for copying the downloaded contents to the external apparatus or recording medium each time before the downloaded contents are to be copied to any external apparatus or recording medium"*, a recitation of the intended use of the claimed

invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

See Notice of References Cited.

A shortened statutory period for reply is set to expire **3** months (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Williams
AU 2437

/Matthew B Smithers/
Primary Examiner, Art Unit 2437